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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/828,763	04/20/2004	Ulrich Schiestl	DT-6796	5252

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EXAMINER
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LOPEZ, MICHELLE

ART UNIT	PAPER NUMBER
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3721

DATE MAILED: 04/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/828,763

Applicant(s)

SCHIELTL ET AL.

Examiner

Michelle Lopez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 7-9 is/are rejected.
- 7) ☒ Claim(s) 5 and 6 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This action is in response to the amendment filed on February 18, 2005.
2. Applicant's arguments, with respect to the rejection(s) of claim(s) 1-2, 4, 7-9 under Odoni (6,722,548) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Walter (6,123,241) and Granacher (6,783,047).

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-2, 4, 7, and 9 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 and 7-8 of U.S. Patent No. 6,722,548.

The differences between the claims of the present application and the claims of the patent are merely in the language and terminology of the claims and these variations and differences would have been obvious to one having ordinary skill in the art.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-4 and 7-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Walter et al. (6,123,241).

Walter discloses a combustion-engined setting tool for driving fastening elements, comprising a fuel source 34; a combustion chamber 12; a fuel guide 40 connecting the fuel source 34 with the combustion chamber 12; at least one electronically controlled valve 42,46 arranged in the fuel guide 40 between the fuel source 34 and the combustion chamber 12; a control unit for opening the electronically control valve 46 as shown in col. 6; 36-58; and a storage chamber arranged between the electronically controlled valve and the combustion chamber as shown in Fig. 44.

With respect to claim 2, Walter discloses actuation means 78,708 that generates a valve opening signal, the control unit opening the electronically controlled valve 46 for the predetermined time period in response to the opening signal generated by the actuation means as shown in col. 8; 11-28.

With respect to claim 3, Walter discloses actuating means 68,740 actuatable when the setting tool is pressed against a constructional component; and a piston 720 arranged in the storage chamber and displaceable in response to actuation of the actuating means as shown in Fig. 44.

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With respect to claim 4, Walter discloses a check valve via 60,62,74,76 arranged in the fuel guide between the electronically controlled valve 46 and the combustion chamber 12.

With respect to claim 7, Walter discloses sensor means for detecting air pressure, temperature, and air humidity, and data transmitting means as shown in Fig. 23 for connecting the sensor means with the control unit (also see col. 17; 53-56, and col. 18; 18-21).

With respect to claim 8, Walter discloses wherein the electronically controlled valve is formed as a solenoid valve 46.

With respect to claim 9, Walter discloses wherein the control unit comprises a data processing unit 300 for evaluating and processing of data transmitted by the data transmitting means.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Granacher (6,783,047).

Granacher discloses a combustion-engined setting tool for driving fastening elements, comprising a fuel source 20; a combustion chamber 23; a fuel guide 22 connecting the fuel source 20 with the combustion chamber 23; at least one electronically controlled valve 21 arranged in the fuel guide between the fuel source 20 and the combustion chamber 23; a control

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unit 50 for opening the electronically control valve 21; and a storage chamber (not shown numerically) arranged between the electronically controlled valve 21 and the combustion chamber 23.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Granacher (6,783,047).

Granacher discloses sensor means and data transmitting means via 51-54 for the purpose of initiating the setting process of the setting tool as shown in col. 3; 15-23, but does not specifically disclose that the sensor means detects air pressure, temperature, and air humidity.

However, it would have been an obvious matter of design choice to have provided sensor means for detecting air pressure, temperature, and air humidity, since applicant has not disclosed that including sensor means for detecting air pressure, temperature, and air humidity solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with Granacher's sensor means for the purpose of properly initiating the setting process of the setting tool.

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***Allowable Subject Matter***

7. Claims 5-6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

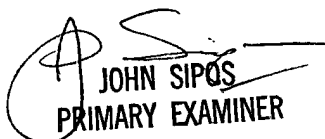
8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Shkolnikov et al'724 and Phillips'519 are cited to shown related inventions.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michelle Lopez whose telephone number is 571-272-4464. The examiner can normally be reached on Monday - Thursday: 8:00 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ML

  
JOHN SIPOS  
PRIMARY EXAMINER